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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,165

10/16/2003

James Goodman

2037.2022-002

6817

21005

7590

02/03/2005

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EXAMINER

TAN, VIBOL

ART UNIT

PAPER NUMBER

2819

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

GA

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,165	<b>Applicant(s)</b> GOODMAN, JAMES	
	<b>Examiner</b> Vibol Tan	<b>Art Unit</b> 2819	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9, 10, 12, 14-17 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 8, 11, 13, 18 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Upon an update search, a new prior art has been found and applied as set forth below.

#### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 1/5/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,466,048 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6, 9, 10, 12, 14-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyakawa et al. (U. S. PAT. 6,522,589).

In claim 1, Miyakawa et al. teaches all claimed features in Fig. 1 an apparatus for processing or storing secure data comprising: a secure port (A2-Ai of I/O Address buffer 3) for transmitting and receiving secure data (A2-Ai); a test port (TEBX) for transmitting and receiving test data (TEBX); and a test mode entry circuit (7) that

causes entry of the apparatus (10) into a test mode (inherent), the test mode entry circuit operable for a predetermined time period (inherent).

In claim 2, Miyakawa et al. further teaches the apparatus of claim 1, wherein the test mode entry circuit (7) is coupled to the secure port (via 3), and when data is applied to the secure port, the test mode entry circuit causes entry of the apparatus into a work mode (operational mode).

In claim 3, Miyakawa et al. further teaches the apparatus of claim 2, wherein the entry into the work mode (operational mode) disables re-entry of the apparatus to the test mode (Test enable buffer 2).

In claim 4, Miyakawa et al. further teaches the apparatus of claim 1, the apparatus of claim 1, wherein the predetermined time period commences approximately coincident (the predetermined time period starts at the same time, inherent) to when power is applied to the apparatus.

In claim 6, Miyakawa et al. further teaches the apparatus of claim 1, wherein the test mode entry circuit (7) is coupled to the test port (TEBX) and entry into the test mode is dependent on test data (TEBX) received through the test port within the predetermined time period (inherent).

In claim 9, Miyakawa et al. further teaches the apparatus of claim 1, further comprising memory (9) for storing the secure data.

In claim 10, Miyakawa et al. further teaches the apparatus of claim 9, wherein the memory is non-volatile (RAM 116 in Fig. 30).

Methods claims 12, 14-17 and 19-21 correspond to detailed circuitry already discussed similarly with regard to claims 1-4, 6, 9 and 10.

4. Claims 5, 7, 8, 11, 13, 18 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vibol Tan whose telephone number is (571) 272-1811. The examiner can normally be reached on Monday-Friday (7:00 AM-4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike J. Tokar can be reached on (571) 272-1812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**VIBOL TAN**  
**PRIMARY EXAMINER**